REMARKS

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application is obvious under the provisions of 35 USC § 103. Furthermore, the Applicants also submit that all of these claims now satisfy the requirements of 35 USC § 112. Thus, the Applicants believe that all of these claims are now in allowable form.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, the Examiner should telephone Mr. Peter L. Michaelson, Esq. at (732) 530-6671 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Specification amendments

Various amendments have been made to the specification to correct minor inadvertent grammatical, punctuation and formal errors.

Substitute Specification

The substitute specification filed herewith contains no new matter. The Applicants now respectfully request that the Examiner enter the substitute specification.

Drawings

The Applicants propose to amend their drawings, as indicated on the red-lined drawing sheets enclosed herewith, to eliminate the figure titles, as being unnecessary, from Figs. 6A, 8, 12, 15, 16, 17, 18, 19 and 20. The Applicants now respectfully request the Examiner's approval of these changes.

Although the Examiner has not yet requested the formal drawings, the Applicants, through a separate letter to the Official Draftsperson, have enclosed these drawings herewith to expedite prosecution.

These drawings include those changes indicated in the Applicants' preliminary amendment filed with the application as well as the proposed changes indicated above. Furthermore, these drawings remedy all the defects noted by the Official Draftsperson in the form PTO-948 included with the office action.

Status of pending claims

Claims 2, 36 and 70 have been replaced by new independent claims 106, 107 and 108, respectively.

Claims 11, 19, 26, 34, 45, 53, 60, 68, 79, 87, 94 and 103 have all been canceled. Claims 3, 10, 13, 16, 17, 20, 25, 28, 32, 35, 37, 41, 44, 47, 51, 54, 56, 59, 62, 65, 66, 69, 71, 75, 78, 81, 84, 85, 88, 90, 93, 97, 100, 104 and 105 have all been amended.

Rejections

A.   35 USC § 112

The Examiner has rejected claims 3-35, 37-69 and
71-105, as they stood prior to this amendment, under the
provisions of 35 USC § 112 as being indefinite.

Specifically, the Examiner points to the
recitation "the tag" appearing in each of claims 3, 37 and
71 that lacks proper antecedent basis. In response, the
Applicants have now amended this recitation in both of these
claims to recite "the code", which finds full antecedent
support in independent claims 106, 107 and 108,
respectively.

As such, the Applicants submit that all their
claims, as they presently stand, are sufficiently definite
and consequently patentable under the provisions of
35 USC § 112.

B.   35 USC § 103

The Examiner has rejected claims 2-35, 36-69 and
70-105, as filed, under the provisions of 35 USC § 103 as
being obvious over the teachings in the Murphy patent
(United States patent 5,305,195 issued on April 19, 1994 to
A. J. Murphy) in view of the Cartellieri et al publication
(C. Cartellieri et al, "The real impact of Internet
Advertising", McKinsey Quarterly, Issue 3, 1997). Inasmuch
as independent claims 2, 36 and 70 are now canceled, this
rejection is moot. However, since claims 2, 36 and 70 have

now been replaced by new claims 106, 107 and 108,
respectively, then, to expedite prosecution, this rejection
will be discussed in the context of those new claims. In
that context, this rejection is respectfully traversed.

The Examiner has stated that the Murphy patent
discloses various elements recited in claim 2, but does not
teach a "computer readable medium used in an internet
environment with web pages.". Given this deficiency, the
Examiner turns to the Cartellieri et al publication for its
disclosure, in page 3, of interstitial advertisement in an
Internet environment. In view of these teachings, the
Examiner concludes that it would have been "obvious to one
of ordinary skill in the art at the time of the invention to
modify the medium of Murphy by use of it on the internet as
disclosed by Cartellieri et al so as to increase the
effectiveness of the advertisement" and as such yield the
present invention.

As the Examiner will soon see, the teachings in
the Murphy patent when combined with those in the
Cartellieri et al publication, as the Examiner suggests,
fall far short of suggesting, even through the slightest
inference, the present invention to one of ordinary skill in
the art. In fact, the combined teachings will lead that
person in a direction totally away from the present
invention.

Specifically, the Murphy patent describes a system
for downloading advertisements from a remote server
(referred to as a "commercial computer") to a client
automated teller machine (ATM) during intervals of low

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utilization of a network connection, through an ATM (not Internet) network connection, between the client ATM and a remote transaction computer, and for rendering such a downloaded advertisement on an interstitial basis while the client is awaiting a response from the transaction computer.

In that regard, col. 1, line 43 et seq. describes the basic interstitial display methodology taught by this patent as follows:

> "A commercial computer communicates
> with each of the remotely located
> terminals and is capable of delivering
> updated video advertising message from a
> sponsor for transmission to each of the
> terminals for display on the video
> display unit. The display of the
> message at the terminal is coordinated
> at the ATM or terminal device being used
> so that the message is displayed only
> during the waiting or not sending time
> of the mainframe computer driving the
> ATM or other terminal."

With reference to the preferred embodiment shown in Figure 2 of this patent, each video advertisement, in the form of compressed digital information, is effectively "pushed" by its commercial computer, e.g., computer 30, via server/buffer 34, to its corresponding recipient terminal(s), e.g., terminals 38 or 40, through a telephonic link(s), e.g., lines 32, where that information is then written into hard disk storage pending its subsequent access and display during an ensuing interstitial interval. Specifically, col. 2, line 50 et seq. states, in pertinent part:

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"The compressed video signals being transmitted from the commercial computer to each of the servers can be transmitted over telephone lines for storage in the hard disc ... . In addition, updated video messages can be transmitted at low speeds during low phone use when the terminals are typically not be used thereby allowing the servers to have the latest advertising message for storage and display."

Therefore, as the Examiner can clearly appreciate, the Murphy patent clearly contemplates an arrangement where advertisements are downloaded, in this case effectively "pushed", to client devices, here being ATMs, during those times when the terminals are not being used, i.e., off-hours. The terminals do not request advertisement downloads; the terminals just receive them. Upon receipt of the downloads, these terminals simply store the corresponding advertisements on their local hard disks for later interstitial access and display.

It is beyond question that this patent does indeed disclose the general concept of interstitial advertising, i.e., displaying a locally stored advertisement during a "wait time", though not in connection with Internet-distributed advertisements.

The Cartellieri et al publication, as of 1997, effectively surveys a marketplace for, describes the capabilities of and forecasts various effects of Internet advertising. Owing to its significant lack of specific technical detail -- which is not surprising given that this publication is clearly written from a marketing or

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advertising content rather than a technical perspective, and its rather expansive but superficial treatment of the subject matter, this publication is of no particular relevance other than perhaps its single mention, as the Examiner points to, on page 3, lines 14-15, of "interstitials" as one form of Internet advertisements. In that regard, this publication simply refers to interstitial advertisements as one of several "straightforward" forms of Internet commercial messages by explicitly stating in col. 3, line 12 et seq.:

> "The emergence of advanced forms of hybrid commercial-editorial content will be driven by consumers' ability to 'tune out' straightforward commercial messages, be they banners, **interstitials** (ads that pop up while users wait for a requested Web page to appear), or standard forms of sponsorship, and by advertisers' desire to influence attitudes in more subtle ways."
> [emphasis added]

The Applicants fail to find any other mention of interstitial advertisements in this publication.

With this single glancing reference to interstitial advertisements, this publication provides absolutely **no** details whatsoever as to how interstitial advertisements are to be implemented.

Therefore, any combination of the teachings of these references, when cast in an Internet context to provide interstitial advertising, would rely on those advertisements being "pushed" to each client (user) computer

during off-hours, i.e., those times when that computer is not being used at all.

In essence, push technology, which the Applicants specifically discuss in detail in page 13, line 8 - page 15, line 29 (in the Background section) of their present specification, when used for content dissemination over the Internet, has garnered very poor user acceptance and is effectively no longer used. The reasons are simple: push technology imposes a burden on the user to download and initially install an appropriate push application program on his(her) client PC and also consumes considerable hard disk space when large quantities of media content are downloaded from a push server to the client PC. Not surprisingly, advertisers have discovered, as noted in page 15, line 24-29 of the present specification, that relatively few PC users will undertake any affirmative action, such as by downloading and installing an application program, almost regardless of its size, to receive advertisements and other such information.

The Applicants teach an strikingly and markedly different concept of providing interstitial advertisements - a concept that simply does not exist or is even suggested in the cited, let alone applied, art.

Specifically, the Applicants' inventive technique, as described on page 22, line 14 et seq. of the present specification, relies on embedding an advertising tag (generally "embedded code") within each of a number of different web pages ("referring web page") stored on one or more remote network web servers. The advertising tag is

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very compact and contains two components: one component for downloading a script from a specified distribution server, and the other component being a network address of an information management server (e.g., an advertising management server).

During the course of browsing the web, a user may select and download to his(her) client browser a web page that contains such a tag. As that web page is downloaded, the browser interprets and processes the coding of that page, including the embedded advertising tag itself.

Once the tag is processed, the client browser downloads a script from its corresponding distribution server, which, in turn when executed, downloads and instantiates an agent. Once the agent is itself executing under the browser, the agent issues a download request to the information management server, as specified in the advertising tag.

In response to this request, the server selects a given advertisement to be rendered at the requesting client browser and then downloads a corresponding AdDescriptor (manifest) file to the client. The browser, in turn (and through the agent), reads the manifest and issues, in succession, a separate request to download each media player file (to the extent it does not then reside on the client computer) and each content file, both as specified in the AdDescriptor file, for that particular advertisement. Once all these files have been downloaded, the advertisement is queued for playing and will be played (by the agent) during an ensuing interstitial interval. The media and player

files are themselves politely downloaded, i.e., in background during idle time of the network connection to the client browser.

As the Examiner can plainly see, the Applicants' inventive approach totally decouples any advertisement content from the referring web page. No such content is stored in the page, nor needs to be.

This inventive approach carries several distinct advantages over traditional Internet advertising approaches. First, since the tag is extremely compact, it does not adversely affect download time for the referring web page. Second, by downloading a manifest file which contains a listing of media and player files (along with their network addresses), the agent, once executing downloads all the information it needs to render any highly media-rich advertisement (or generally speaking any information object). Third, whenever ad campaigns change, the advertisement can be readily changed without affecting the coding of any of the referring web pages -- which can save considerable labor and expense. Fourth, the manifest file as well as all the information object files are "politely" downloaded by the agent in background during network idle time, i.e., when network connections to the browser are not busy such as while a user is viewing a web page that has just been rendered.

Moreover, in sharp contradistinction to the approach taught by the Murphy patent, the Applicants' inventive technique does not rely on "pushing" any content to the client PC. Rather, the client PC, specifically the

client browser, "pulls" the content by issuing, in response to execution of an advertisement tag in a referring web page, a download request to an advertising management server specified in that tag. Hence, the present invention totally eliminates all the deficiencies inherent in the "push" approach, which would invariably arise if an Internet advertising system were to be produced based, as the Examiner has proposed, on the combined teachings of the Murphy patent and the Cartellieri publication.

Both the Murphy patent and the Cartellieri et al publication, whether taken singly or as combined by the Examiner, are totally devoid of any teachings that even suggest the use of embedding code in a referring web page that effectively decouples object content from that page and where that code, when executed by a client computer, causes that computer to politely download at least one object file and, during an ensuing interstitial interval, process that file so as to render the object.

In that regard, the Murphy patent does not utilize any HTML coding at all, inasmuch as it relies solely on "pushing" compressed video to local clients, there ATMs, for storage pending subsequent display. The Cartellieri et al publication makes one slight mention of "interstitials" without delineating any specific implementational details.

There are simply no disclosures or suggestions, of any type, whether explicit or implicit, in either or both of these references that would motivate a person of ordinary skill in the art, when faced with the task of implementing Internet-distributed interstitial advertising, towards the

present invention. Moreover, not only do the existent teachings of these references stop considerably <u>short</u> of even suggesting the present inventive technique, but, more to the point, those teachings are likely to direct that person <u>away</u> from it!

Independent claim 106 contains appropriate recitations directed to the present invention. Specifically, this claim recites as follows, with those recitations shown in bolded type:

"A computer readable medium storing a first web page wherein the first web page comprises a plurality of computer readable instructions, **the instructions representing page content and embedded code, wherein the code, when executed by a client computer, causes the computer to:**
download, from a network server and while the computer renders the first web page to a user through an output device operative in conjunction with the computer, at least one file which is to be subsequently employed, by the processor, to render an information object; and
in response to a user-initiated event, detected by the computer, for transitioning from the first web page to a next successive web page and which signifies a start of a next interstitial interval, suspend further downloading of files and process the one file so as to render the information object through the output device to the user during the interval; and
wherein use of the code eliminates a need to store content for the information object within the first web page thereby decoupling the object

content from the first web page."
[emphasis added]

Nearly identical and parallel distinguishing recitations appear in the Applicants' other pending independent claims, i.e., method claim 107 and apparatus claim 108.

As such, the Applicants submit that each of their independent claims, namely claims 106, 107 and 108, is not rendered obvious by the teachings in the Murphy patent, whether taken singly or in conjunction, as the Examiner surmises, with the Cartellieri et al publication.

Accordingly, the Applicants submit that each of their independent claims is patentable under the provisions of 35 USC § 103.

Each of the remaining claims, specifically claims 3-10, 12-18,20-25, 27-33, 35, 37-44, 46-52, 54-59, 61-67, 69, 71-78, 80-86, 88-93, 95-102 and 104 and 105, depends, either directly or indirectly, from independent claim 106, 107 or 108 and recites further distinguishing features of the present invention. Therefore, the Applicants submit that each of these dependent claims is patentable over the teachings of the Murphy patent and the Cartellieri et al publication for the same exact reasons set forth above. Hence, the Applicants submit that each of these dependent claims is also patentable under the provisions of 35 USC § 103.
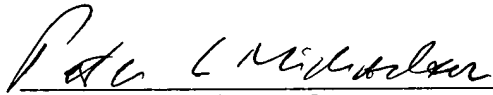
Conclusion

Thus, the Applicants submit that none of the claims, presently in the application, is obvious under the provisions of 35 USC § 103. Furthermore, the Applicants also submit that all of these claims now fully satisfy the requirements of 35 USC § 112.

Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

Respectfully submitted,

May 25, 2001

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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **May 25**, **2001** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

Peter L. Michaelson   _30,090_
Signature   Reg. No.

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